

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant:	Baker et al.	Application No.:	09/825,431
Filing Date:	April 3, 2001	Confirmation No.:	2071
Examiner:	Rachna Singh DESAI	Attorney Docket:	209.1001
Art Unit:	2176	Customer No.:	23280
Title:	<b>PRIVILEGED COMMUNICATION SYSTEM WITH ROUTING CONTROLS</b>		

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P.O. Box 1450  
Alexandria, VA 22313-1450

April 2, 2010

**APPEAL BRIEF UNDER 37 C.F.R. § 41.37**

Sir:

Appellants submit this brief for the consideration of the Board of Patent Appeals and Interferences (the “Board”) in support of their appeal of the Final Rejection dated June 2, 2009 in this application. The statutory fee of \$ 540.00 for filing an appeal brief is being paid concurrently herewith. If any additional fees are deemed to be due at this time or any fees have been overpaid, the Commissioner is authorized to charge the payment of the additional fees or credit the overpayment to Deposit Account No. 50-0552.

I. REAL PARTY IN INTEREST

The real party in interest is Purdue Pharma LP, a Delaware limited partnership having offices at One Stamford Forum, Stamford, CT 06901, and the assignee of the entire right, title and interest in the above-identified patent application. The invention was assigned to Purdue Pharma LP from Clarios Corporation by an assignment which was recorded on April 1, 2010, at reel 024175, frame 0773. The invention was assigned to Clarios Corporation from Purdue Pharma LP by an assignment which was recorded on December 15, 2005, at reel 017124, frame 0348. The invention was assigned to Purdue Pharma LP from the inventors, Stuart D. Baker and Phillip C. Strassburger, by an assignment which was recorded on April 3, 2001, at reel 011666, frame 0691.

II. RELATED APPEALS AND INTERFERENCES

Appellants, their legal representatives, and assignee are not aware of any appeal, interference or judicial proceeding that directly affects, will be directly affected by, or will have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

Claims 1 to 27, 41-59 and 71-73 are pending and have been finally rejected by the Examiner as per the Final Office Action mailed on June 2, 2009.

The rejection of claims 1 to 27, 41-59 and 71-73 is thus appealed. A copy of claims 1 to 27, 41-59 and 71-73 is attached hereto as Appendix A.

#### IV. STATUS OF AMENDMENTS

No amendments were filed after the rejection of claims 1 to 27, 41-59 and 71-73 in the Final Office Action mailed on June 2, 2009. A Notice of Appeal was filed on September 1, 2009 and received by the U.S.P.T.O. on September 3, 2009.

#### V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Independent claim 1 recites a digital communication system to denote confidentiality of a digital communication comprising:

- a first memory containing a program executable by a processor to
  - attach a privileged attribute to a digital communication (e.g., paragraph [0004]), the privileged attribute selected by the creator of the digital communication before the digital communication is sent (e.g., paragraph [0037]); and
  - create a privileged distribution list of at least one intended recipient (e.g., paragraph [0005]) and associate the privileged distribution list with the digital communication when the digital communication is created (e.g., paragraph [0036]); and
  - a second memory containing a program executable by a processor to:
    - restrict access to the privileged digital communication to the at least one intended recipient according to the privileged distribution list (e.g., paragraph [0004]);
    - restrict routing of the privileged digital communication to the intended recipients and prevent forwarding of the digital communication to an unintended recipient (e.g., paragraphs [0036] and [0043]); and
    - store the privileged digital communication in a segregated location for privileged digital communications on a data storage device (e.g., paragraphs [0004] and [0019]),
- wherein the intended recipients are selected by the creator of the digital communication before the digital communication is sent (e.g., paragraph [0037]).

Dependent claim 10 recites the communication system of claim 1 further comprising a confidentiality notice that is displayed to a user and acknowledged by the user before displaying the privileged communication (e.g., paragraph [0046]).

Independent claim 18 recites a digital communication system for denoting confidentiality of a digital communication comprising:

- a processor (e.g., paragraph [0007]); and
- a memory containing a program executable by the processor to attach an executable module to a digital communication (e.g., paragraph [0007]) when the digital communication is created, the executable module constructed and arranged to:
  - create a privileged distribution list of intended recipients of the digital communication to which it is attached when the digital communication is created (e.g., paragraph [0007]);
  - restrict access to the digital communication to which it is attached to the intended recipients (e.g., paragraph [0007]); and
  - restrict routing of the digital communication to which it is attached to the intended recipients and prevent forwarding of the digital communication to an unintended recipient, wherein the intended recipients are selected by the creator of the digital communication before the digital communication is sent (e.g., paragraph [0007]).

Dependent claim 22 recites the communication system of claim 18 further comprising a confidentiality notice that is displayed to a user and acknowledged by the user before displaying the privileged communication (e.g., paragraph [0046]).

Independent claim 41 recites a method for creating an attorney-client privileged electronic communication comprising the steps of:

- creating an electronic communication (e.g., paragraph [0006]);
- marking the electronic communication privileged with a privileged attribute which is selected by the creator of the electronic communication (e.g., paragraph [0006]) before the electronic communication is sent,

storing the electronic communication in a segregated location for privileged electronic communications on a data storage device (e.g., paragraph [0006]);

configuring access rights to the electronic communication and associating a privileged distribution list with the digital communication (e.g., paragraph [0006]); and

enforcing said access rights by managing access to the electronic communication and controlling the manipulation of its contents based upon the privileged distribution list (e.g., paragraph [0006]);

wherein the access rights include:

forwarding of the communication (e.g., paragraph [0006]);

replying (e.g., paragraph [0006]); and

replying with copies to pre-selected recipients (e.g., paragraph [0006]).

Dependent claim 44 recites the method of claim 41 further comprising: displaying confidentiality notice to a user; and, requiring acknowledgment by the user of the confidentiality notice before displaying the privileged communication (e.g., paragraph [0046]).

Independent claim 49 recites a method for creating a digital communication protected by privilege comprising the steps of:

creating an executable module constructed and arranged to instruct a computer, according to a privileged distribution list associated with the digital communication when the digital communication was created, to restrict access to the communication to which the executable module is attached in order to maintain the application of the privilege (e.g., paragraph [0008]);

attaching the executable module to the communication (e.g., paragraph [0008]), whereby the executable module instructs the computer to restrict access to the communication to recipients selected by the creator of the digital communication before the digital communication is sent (e.g., paragraph [0077]).

Dependent claim 55 recites the method of claim 49 further comprising displaying a confidentiality notice to a user and requiring that the confidentiality notice be acknowledged by the user before the privileged communication is displayed (e.g., paragraph [0046]).

Independent claim 57 recites a method for creating a privileged digital document, comprising the steps of:

creating an executable module which instructs a computer to maintain confidentiality in communication of the privileged digital document to which the executable module is attached by restricting access to the digital document and managing manipulation of its contents, according to a privileged distribution list created and associated with the digital document (e.g., paragraph [0008]);

attaching the executable module to the privileged digital document (e.g., paragraph [0008]), whereby the executable module instructs the computer to restrict access to the privileged digital document to recipients selected by the creator of the privileged digital document before the privileged digital document is sent (e.g., paragraph [0077]).

Independent claim 71 recites a digital communication system to comprising:

a first memory containing a program executable by a processor to:

attach a privileged attribute to a digital communication (e.g., paragraph [0004]), the privileged attribute selected by the creator of the digital communication before the digital communication is sent (e.g., paragraph [0037]);

a second memory containing a program executable by a processor to:

restrict access to the privileged digital communication to an intended recipient and pre-registered designees of attorney recipients in accordance with the privileged attribute (e.g., paragraph [0004]); and

store the privileged digital communication in a segregated location for privileged digital communications on a data storage device (e.g., paragraph [0004]).

Independent claim 72 recites a digital communication system comprising:

a processor; and

a memory containing a program executable by the processor to attach an executable module to a digital communication when the digital communication is created (e.g., paragraph [0004]), the executable module constructed and arranged to:

restrict access to the digital communication to which it is attached to an intended recipient and pre-registered designees of attorney recipients selected by the creator of the digital communication before the digital communication is sent (e.g., paragraph [0004]);

restrict routing of the digital communication to which it is attached to the intended recipient and pre-registered designees of attorney recipients (e.g., paragraph [0004]).

## VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether claims 1-2, 12, 17-18, 23, 25, 26, 49, 53, 56-59, and 71-72 are unpatentable under 35 U.S.C. §103(a) over Turnbull et al., U.S. Patent No. 6,092,201, in view of Liu et al., U.S. Patent No. 6,760,752.

B. Whether claims 3-11, 13-16, 19-22, 24, 27, 41-48, 50-52, 54-55, and 73 are unpatentable under 35 U.S.C. §103(a) over Turnbull et al., U.S. Patent No. 6,092,201, in view of Liu et al., U.S. Patent No. 6,760,752, and further in view of Dickinson, III et al., U.S. Patent Application Publication No. 2003/0196098.

## VII. ARGUMENTS

### A. Rejections under 35 U.S.C. § 103(a) over Turnbull et al., U.S. Patent No. 6,092,201, in view of Liu et al., U.S. Patent No. 6,760,752

Claims 1, 2, 12, 17-18, 23, 25, 26, 49, 53, 56-59, and 71-72 were rejected under 35 U.S.C. § 103(a) over Turnbull et al., U.S. Patent No. 6,092,201 (“the Turnbull patent”), in view of Liu et al., U.S. Patent No. 6,760,752 (“the Liu patent”).

#### 1. Claims 1, 2, 12, and 17

Independent claim 1 recites:

A digital communication system to denote confidentiality of a digital communication comprising:  
a first memory containing a program executable by a processor to:  
attach a privileged attribute to a digital communication, the privileged attribute selected by the creator of the digital communication before the digital communication is sent; and  
create a privileged distribution list of at least one intended recipient and associate the privileged distribution list with the digital communication when the digital communication is created; and  
a second memory containing a program executable by a processor to:  
restrict access to the privileged digital communication to the at least one intended recipient according to the privileged distribution list;  
restrict routing of the privileged digital communication to the intended recipients and prevent forwarding of the digital communication to an unintended recipient; and  
store the privileged digital communication in a segregated location for privileged digital communications on a data storage device,  
wherein the intended recipients are selected by the creator of the digital communication before the digital communication is sent.



The Examiner stated that “Turnbull does not expressly teach [to] *store the privileged digital communication in a segregated location for privileged digital communications on a data storage device.*” *Office Action*, page 4 (emphasis in the original). The Examiner then contended that the Liu patent “discloses *storing the privileged digital communication in a segregated location for privileged communications on a data storage device* (See column 21, lines 6-20).” *Id.* (emphasis in the original).

Appellants respectfully submit that the portion of the Liu patent relied upon by the Examiner does not disclose storing a privileged digital communication (i.e., an email) in a segregated location on a data storage device as recited in claim 1, as there is no mention of any digital communications (i.e., emails) in the portion of the Liu patent relied upon by the Examiner. The portion relied upon by the Examiner states that “... signature manager 132 stores the **private key** and pre-computed data (**which is part of the private key**) locally (to the disk on the client computer) encrypted by a symmetric key derived from the signature phrase (245).” *The Liu patent*, column 21, lines 11-14 (emphasis added). Appellants respectfully submit that “a private key” is not the same as “a privileged digital communication” (i.e., an email). *See, e.g., the Liu patent*, column 6, lines 32-45<sup>1</sup>.

Accordingly, Appellants submit that the disclosure relied upon by the Examiner does not read on the step of storing a privileged digital communication in a segregated location on a data storage device as recited in claim 1, and that the rejection is deficient as the combination of the cited references does not teach or suggest each and every element of claim 1 (e.g., the combination of the cited references does not teach or suggest to “store the privileged digital communication in a segregated location for privileged digital communications on a data storage device” as recited in claim 1).

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<sup>1</sup> Column 6, lines 32-45, of the Liu patent recites “... the invention provides an apparatus for transferring a message securely from a sender to a recipient over a network including a composer operable to create a message and retrieve a public key of the recipient from an external key server just prior to sending the message, a signature engine operable to sign the message using the private key of the sender, an encryption engine operable to encrypt the signed message using a public key encryption algorithm and the public key of the recipient producing an encrypted signed message, and a wrapping application operable to generate an E-mail message addressed to the recipient, attach the encrypted signed message as an attachment to the E-mail message and transmit the E-mail message to the recipient.”

Appellants further submit that the combination of the cited references does not teach or suggest to “attach a privileged attribute to a digital communication, the privileged attribute selected by the creator of the digital communication before the digital communication is sent” as recited in claim 1. The Examiner contended that this feature is disclosed in column 4, lines 7-30<sup>2</sup>, of the Turnbull patent. Appellants however respectfully note that there is no disclosure of any digital communications (i.e., emails) in column 4, lines 7-30, of the Turnbull patent. Accordingly, Appellants submit that column 4, lines 7-30, of the Turnbull patent cannot teach or suggest classifying a digital communication as privileged or confidential (i.e., “attach a privileged attribute” to a digital communication) as recited in claim 1. Furthermore, Appellants submit that column 4, lines 7-30, of the Turnbull patent does not mention “the creator of digital communication,” and therefore cannot teach or suggest a privileged attribute “selected by the creator of the digital communication before the digital communication is sent” as recited in claim 1.

Appellants further submit that the combination of the cited references does not teach or suggest to “create a privileged distribution list of at least one intended recipient ... when the digital communication is created” as recited in claim 1. The Examiner contended that this feature is described in column 3, lines 35-45, column 4, lines 25-30, and column 6, lines 28-49, of the Turnbull patent. *Office Action*, page 3. Appellants respectfully note that the “shared lists” described in these portions of the Turnbull patent were purportedly created before the creation of the secured communication described therein (i.e., described in column 6, lines 28-49 of the

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<sup>2</sup> Column 4, lines 7-30, of the Turnbull patent recites:

The directory 20 is a repository, or database, of certificates (e.g., verification and/or encryption), cross-certificates 36, authority revocation lists 38, and certificate revocation lists 40. The directory 20 may be a stand-alone database (or repository accessible by a suitable interface, for example Lightweight Directory Access Protocol LDAP) or contained within the certification authority 22 and/or the server/manager 24. The certification authority 22 may be a stand-alone computer that controls policy issues for the secured communications system 10. Alternatively, this policy could be set by the server/manager 24. The security policy of the system 10 indicates which users are authorized to create shared lists, which users are authorized to access the shared lists, under which conditions such access is allowed, which users can establish trust (i.e. communicate with securely, for example using encryption and/or digital signature functionality) with third party end-users (i.e., users not affiliated with the secured communications system 10 and/or not recognized by certification authority 22), and which users are authorized to modify shared lists. Note that the certificates may be any type of public key certificate and/or certificates that contain data items other than public keys, for example attribute certificates which might convey access privileges or authorization for certain actions.

Turnbull patent), e.g., because the Turnbull patent describes a user using a shared list “to process secure communications, i.e., encrypt outgoing messages with the public keys of the intended recipients and verify signatures on received messages.” *The Turnbull patent*, column 3, lines 41-45. Appellants therefore submit that the “shared lists” described in the Turnbull patent do not read on creating the privileged distribution list of at least one intended recipient “when the digital communication is created” as recited in claim 1.

In addition, Appellants submit that the combination of the cited references does not teach or suggest to “restrict access to the privileged digital communication to the at least one intended recipient according to the privileged distribution list” as recited in claim 1. The Examiner contended that this feature is described in column 3, lines 14-51, of the Turnbull patent<sup>3</sup>. Appellants respectfully note that the “access” described in this portion of the Turnbull patent is access to “a shared list,” rather than a communication itself. Accordingly, Appellants submit that the portion relied upon by the Examiner does not read on the feature of “restrict[ing] access to the privileged digital communication to the at least one intended recipient according to the privileged distribution list” recited in claim 1.

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<sup>3</sup> Column 3, lines 14-51, of the Turnbull patent recites:

Generally, the present invention provides a method and apparatus for extending secure communication operations via shared lists. This is accomplished by creating a shared list in accordance with authorization parameters by one user and subsequently accessing the shared list via the authorization parameters set by this and other users. To create the list, a user (e.g., an end-user, a certification authority/administrator, etc.) within the secured communication system determines whether it has been enabled, or authorized, to create a shared list. If so, the user identifies at least one other user to be added to the shared list. Having identified another user, the end-user creating the shared list verifies that the secure communication parameters (which may include encryption public key certificate, signature verification public key certificate, and/or a signature verification public key certificate of a certification authority) it has received regarding the another user is trustworthy. If the secure communication parameters are verified as trustworthy, the secure communication parameters of the another user are added to the shared list. To authenticate the shared list (i.e. allowing subsequent verification of its authenticity), the user creating the list signs it. Once the list is created, other users, if authorized, may access the shared list to retrieve certificates (e.g., encryption and/or signature verification) of the users contained in the list. With such a method and apparatus, users can access a user created shared list to retrieve certificates for each member of a group of recipients without having to access a directory. Thus, if a user does not have access to a directory, it can still process secure communications, i.e., encrypt outgoing messages with the public keys of the intended recipients and verify signatures on received messages. The shared list also allows an end-user the ability to obtain certificates of a group of end-users, certification authorities, and/or administrators simultaneously from another user, instead of a certificate at a time. In addition, the present method and apparatus provides control over the ability to create, use and/or modify a shared list.

Appellants further submit that the combination of the cited references does not teach or suggest to “prevent forwarding of the digital communication to an unintended recipient” as recited in claim 1. The Examiner contended that this feature is described in columns 3-4 and column 6, lines 28-49, of the Turnbull patent. *See Office Action*, page 3. Appellants respectfully submit that although “a secured message” is mentioned in column 6, line 41, of the Turnbull patent, the Turnbull patent does not discuss any forwarding of the secured message by the intended recipients. Therefore, the Turnbull patent cannot teach or suggest to “prevent forwarding of the digital communication to an unintended recipient” as recited in claim 1.

For the foregoing reasons, Appellants submit that the *prima facie* case of obviousness has not been established and that the combination of the cited references does not render claim 1 obvious.

Claims 2, 12 and 17 depend from claim 1 and therefore are not rendered obvious by the combination of the cited references by virtue of their dependency from claim 1. *See, e.g., In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988) (“Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious. *Hartness Int’l, Inc. v. Simplimatic Eng’g Co.*, 819 F.2d 1100, 1108, 2 U.S.P.Q.2d 1826, 1831 (Fed. Cir.1987); *In re Abele*, 684 F.2d 902, 910, 214 U.S.P.Q. 682, 689 (CCPA 1982); *see also In re Sernaker*, 702 F.2d 989, 991, 217 U.S.P.Q. 1, 3 (Fed. Cir.1983)”).

Reversal of the rejection of claims 1, 2, 12, and 17 is respectfully requested.

## 2. Claim 18: Argued Separately

Independent claim 18 recites:

A digital communication system for denoting confidentiality of a digital communication comprising:  
a processor; and  
a memory containing a program executable by the processor to attach an executable module to a digital communication when the digital communication is created, the executable module constructed and arranged to:  
create a privileged distribution list of intended recipients of the digital communication to which it is attached when the digital

communication is created;  
restrict access to the digital communication to which it is attached to the intended recipients; and  
restrict routing of the digital communication to which it is attached to the intended recipients and prevent forwarding of the digital communication to an unintended recipient, wherein the intended recipients are selected by the creator of the digital communication before the digital communication is sent.

Appellants respectfully submit that the combination of the cited references does not teach or suggest to “create a privileged distribution list of intended recipients of the digital communication to which it is attached when the digital communication is created” as recited in claim 18 for the reasons set forth above in response to the obviousness rejection of claim 1.

Appellants further submit that the combination of the cited references does not teach or suggest to “restrict access to the digital communication to which it is attached to the intended recipients” as recited in claim 18 for the reasons set forth above in response to the obviousness rejection of claim 1.

Appellants also submit that the combination of the cited references does not teach or suggest to “prevent forwarding of the digital communication to an unintended recipient” as recited in claim 18 for the reasons set forth above in response to the obviousness rejection of claim 1.

In addition, Appellants respectfully submit that the combination of the cited references does not teach or suggest attaching “an executable module to a digital communication when the digital communication is created” as recited in claim 18. The Examiner did not disclose in the Office Action where this feature of claim 18 is described in the Turnbull patent, and the Appellants were not able to find a mention or a description of such a module in the Turnbull patent or the Liu patent.

Accordingly, Appellants submit that the *prima facie* case of obviousness has not been established and that claim 18 is not rendered obvious by the combination of the cited references.

Reversal of the rejection of claim 18 is respectfully requested.

### 3. Claims 23, 25 and 26: Argued Separately

Claim 23, 25 and 26 depend from claim 18 through claim 22, which was not included in the present rejection.

Claim 22 recites “[t]he communication system of claim 18 further comprising a confidentiality notice that is displayed to a user and acknowledged by the user before displaying the privileged communication.”

The Examiner acknowledged that “Turnbull does not teach a confidentiality notice [that] is displayed to the user and acknowledged before displaying the communication.” *Office Action*, page 14. Appellants respectfully submit that the Liu patent does not mention or describe a confidentiality notice as recited in claim 22 and therefore cannot cure the deficiency of the Turnbull patent. In fact, the Examiner did not even include claim 22 in the present rejection.

Appellants therefore respectfully submit that the combination of the cited references does not teach or suggest a digital communication system comprising a confidentiality notice that is (i) “displayed to a user” and (ii) “acknowledged by the user before displaying the privileged communication” as recited in claim 22, and that claim 22 is not rendered obvious by the combination of the cited references.

Claims 23, 25 and 26 depend from claim 22 and therefore are not rendered obvious by the combination of the cited references by virtue of their dependency from claim 22.

Reversal of the rejection of claims 23, 25 and 26 is respectfully requested.

### 4. Claims 49, 53 and 56: Argued Separately

Independent claim 49 recites:

A method for creating a digital communication protected by privilege comprising the steps of:  
creating an executable module constructed and arranged to instruct a computer, according to a privileged distribution list associated with the digital communication when the digital communication was created, to restrict access to the communication to which the executable module is attached in

order to maintain the application of the privilege;  
attaching the executable module to the communication,  
whereby the executable module instructs the computer to restrict  
access to the communication to recipients selected by the creator of  
the digital communication before the digital communication is  
sent.

Appellants respectfully submit that the combination of the cited references does not teach or suggest “creating an executable module” as recited in claim 49, for the reasons set forth above in response to the obviousness rejection of claim 18.

Appellants further submit that the combination of the cited references does not teach or suggest “attaching the executable module to the communication” as recited in claim 49, as the cited references do not mention or describe such a module.

Appellants further submit that the combination of the cited references does not teach or suggest “to restrict access to the communication to recipients selected by the creator of the digital communication before the digital communication is sent” as recited in claim 49, for the reasons set forth above in response to the obviousness rejection of claim 1.

Accordingly, Appellants submit that the *prima facie* case of obviousness has not been established and that claim 49 is not rendered obvious by the combination of the cited references.

Claims 53 and 56 depend from claim 49 and therefore are not rendered obvious by the combination of the cited references by virtue of their dependency from claim 49.

Reversal of the rejection of claims 49, 53 and 56 is respectfully requested.

#### 5. Claims 57, 58 and 59: Argued Separately

Independent claim 57 recites:

A method for creating a privileged digital document, comprising the steps of:  
creating an executable module which instructs a computer to maintain confidentiality in communication of the privileged digital document to which the executable module is attached by restricting access to the digital document and managing manipulation of its contents, according to a privileged distribution

list created and associated with the digital document;  
attaching the executable module to the privileged digital document, whereby the executable module instructs the computer to restrict access to the privileged digital document to recipients selected by the creator of the privileged digital document before the privileged digital document is sent.

Appellants respectfully submit that the combination of the cited references does not teach or suggest creating “an executable module” as recited in claim 57, for the reasons set forth above in response to the obviousness rejection of claim 18.

Appellants further submit that the combination of the cited references does not teach or suggest attaching “the executable module to the privileged digital document” as recited in claim 57, for the reasons set forth above in response to the obviousness rejection of claim 18.

Appellants also submit that the combination of the cited references does not teach or suggest to attach the executable module which “instructs the computer to restrict access to the privileged digital document to recipients selected by the creator of the privileged digital document before the privileged digital document is sent” as recited in claim 57, for the reasons set forth above in response to the obviousness rejection of claim 1.

Appellants further submit that the combination of the cited references does not teach or suggest an executable module which is attached to the privileged document and instructs a computer to maintain confidentiality of the privileged document by “managing manipulation of its contents, according to a privileged distribution list created and associated with the digital document,” because the combination of the cited references does not mention or describe such a module.

Accordingly, Appellants submit that the *prima facie* case of obviousness has not been established and that the combination of the cited references does not render claim 57 obvious.

Claims 58 and 59 depend from claim 57 and therefore are not rendered obvious by the combination of the cited references by virtue of their dependency from claim 57.

Reversal of the rejection of claims 57, 58 and 59 is respectfully requested.



6. Claim 71: Argued Separately

Independent claim 71 recites:

A digital communication system to comprising:  
a first memory containing a program executable by a processor to:  
attach a privileged attribute to a digital communication, the privileged attribute selected by the creator of the digital communication before the digital communication is sent;  
a second memory containing a program executable by a processor to:  
restrict access to the privileged digital communication to an intended recipient and pre-registered designees of attorney recipients in accordance with the privileged attribute; and  
store the privileged digital communication in a segregated location for privileged digital communications on a data storage device.

Appellants respectfully submit that the combination of the cited references does not teach or suggest to “attach a privileged attribute to a digital communication, the privileged attribute selected by the creator of the digital communication before the digital communication is sent” as recited in claim 71, for the reasons set forth in response to the obviousness rejection of claim 1.

Appellants further submit that the combination of the cited references does not teach or suggest to “store the privileged digital communication in a segregated location for privileged digital communications on a data storage device” as recited in claim 71, for the reasons set forth above with regard to claim 1.

Accordingly, Appellants submit that the *prima facie* case of obviousness has not been established and that claim 71 is not rendered obvious by the combination of the cited references.

Reversal of the rejection of claim 71 is respectfully requested.

7. Claim 72: Argued Separately

Independent claim 72 recites:

A digital communication system comprising:  
a processor; and

a memory containing a program executable by the processor to attach an executable module to a digital communication when the digital communication is created, the executable module constructed and arranged to: restrict access to the digital communication to which it is attached to an intended recipient and pre-registered designees of attorney recipients selected by the creator of the digital communication before the digital communication is sent; restrict routing of the digital communication to which it is attached to the intended recipient and pre-registered designees of attorney recipients.

Appellants respectfully submit that the combination of the cited references does not teach or suggest “to attach an executable module to a digital communication when the digital communication is created” as recited in claim 72, for the reasons set forth above in response to the obviousness rejection of claim 18.

Appellants further submit that the combination of the cited references does not teach or suggest “restrict access to the digital communication to which it is attached to an intended recipient and pre-registered designees of attorney recipients selected by the creator of the digital communication before the digital communication is sent” as recited in claim 72, for the reasons set forth above in response to the obviousness rejection of claim 1.

Appellants further submit that the combination of the cited references does not teach or suggest restricting “routing of the digital communication to which it is attached to the intended recipient and pre-registered designees of attorney recipients,” for the reasons set forth above in response to the obviousness rejection of claim 1.

Accordingly, Appellants submit that the *prima facie* case of obviousness has not been established and that claim 72 is not rendered obvious by the combination of the cited references.

Reversal of the rejection of claim 72 is respectfully requested.

B. Rejections under 35 U.S.C. 103(a) over Turnbull et al., U.S. Patent No. 6,092,201, in view of Liu et al., U.S. Patent No. 6,760,752, and further in view of Dickinson, III et al., U.S. Patent Application Publication No. 2003/0196098.

Claims 3-11, 13-16, 19-22, 24, 27, 41-48, 50-52, 54-55, and 73 were rejected under 35 U.S.C. § 103 (a) over the combination of the Turnbull patent, the Liu patent and U.S. Patent Application Publication No. 2003/0196098 to Dickinson, III et al. (“the Dickinson publication”).

Claims 3-11, 13-16, 19-22, 24, 27, 41-48, 50-52, 54-55, and 73 each depends from claim 1, 18, 41 or 49, which are all directed in part to a digital communication which itself controls where the communication may be sent as recited in the present claims.

Appellants respectfully note that the Dickinson publication purportedly directed to e-mail firewalls and states in part that e-mail firewalls (i.e., emails firewalls 105) “control transmission of electronic messages between an internal site and one or more external sites.” *The Dickinson publication*, paragraph [0017]. Accordingly, Appellants submit that the combination of Dickinson publication with the Turnbull patent and the Liu patent cannot teach or suggest a digital communication which itself controls where the communication may be sent as recited in the present claims.

Appellants further submit that the Dickinson publication and the Liu patent are not properly combinable, e.g., because the Liu patent teaches away from the combination. As stated above, the Dickinson publication is purportedly directed to an e-mail firewall. *See, e.g., The Liu patent*, Abstract. The Liu patent however states that “the additional security measures [i.e., firewalls] can have undesirable effects in limiting the kind or form of traffic that is able easily to be transmitted through the gateway.” *See, the Liu patent*, column 1, lines 45-50 (emphasis added). Appellants therefore respectfully submit that the Liu patent, which states that firewalls are undesirable, and the Dickinson publication, which describes firewalls, are not properly combinable.

Appellants further submit that, even if the Liu patent is properly combinable with the Dickinson publication (a position which is traversed by the Appellants), the combination of the

Turnbull patent, the Liu patent and the Dickinson publication does not render claims 3-11, 13-16, 19-22, 24, 27, 41-48, 50-52, 54-55, and 73 obvious, as the combination of the cited references does not teach or suggest each and every element of claims 3-11, 13-16, 19-22, 24, 27, 41-48, 50-52, 54-55, and 73, e.g., as described below.

1. Claims 3-9, 13-16 and 73

Claims 3-9 and 13-16 depend from claim 1. Claim 1 was discussed above, and recites in part a program that stores “the privileged digital communication in a segregated location for privileged digital communications on a data storage device.”

As discussed above in response to the obviousness rejection of claim 1 over the combination of the Turnbull patent and the Liu patent, the Turnbull patent and the Liu patent do not teach or suggest to “store the privileged digital communication in a segregated location for privileged digital communications on a data storage device” as recited in claim 1. In fact, the Examiner acknowledged that “Turnbull does not expressly teach *store the privileged digital communication in a segregated location for privileged digital communications on a data storage device.*” *Office Action*, page 4 (emphasis added).

Appellants respectfully submit that the Dickinson publication also does not teach or suggest to “store the privileged digital communication in a segregated location for privileged digital communications on a data storage device,” as it does not mention or describe storing any digital communications “in a segregated location” as recited in claim 1. Accordingly, Appellants respectfully submit that the Dickinson publication does not cure this deficiency of the Turnbull patent and the Liu patent.

Appellants further submit that the combination of the cited references does not teach or suggest to “attach a privileged attribute to a digital communication, the privileged attribute selected by the creator of the digital communication before the digital communication is sent” as recited in claim 1 for the reasons set forth above in response to the obviousness rejection of claim 1 over the combination of Turnbull patent and the Liu patent. The Dickinson publication also does not teach or suggest to “attach a privileged attribute to a digital communication, the

privileged attribute selected by the creator of the digital communication before the digital communication is sent as recited in claim 1,” as it is purportedly directed to an e-mail firewall and therefore describes actions which occur after the digital communication is sent, rather than “before the digital communication is sent” as recited in claim 1. Appellants therefore submit that the Dickinson publication again cannot cure the deficiency of the Turnbull patent and the Liu patent.

Appellants also submit that the combination of the cited references does not teach or suggest to “create a privileged distribution list of at least one intended recipient ... when the digital communication is created” as recited in claim 1 for the reasons set forth above in response to the obviousness rejection of claim 1 over the combination of Turnbull patent and the Liu patent. As stated above, the Dickinson patent also does not teach or suggest to “create a privileged distribution list of at least one intended recipient ... when the digital communication is created,” e.g., because the Dickinson publication is purportedly directed to an e-mail firewall and therefore describes actions which occur after the digital communication is created. Accordingly, Appellants respectfully submit that the Dickinson patent again cannot cure the deficiency of the Turnbull and the Liu patent.

In addition, Appellants submit that the combination of the cited references does not teach or suggest to “restrict access to the privileged digital communication to the at least one intended recipient according to the privileged distribution list” as recited in claim 1 for the reasons set forth above in response to the obviousness rejection of claim 1 over the combination of Turnbull patent and the Liu patent. Appellants respectfully note that the Dickinson publication also does not teach or suggest to “restrict access to the privileged digital communication to the at least one intended recipient according to the privileged distribution list” as recited in claim 1, and therefore again cannot cure the deficiency of the Turnbull patent and the Liu patent.

Appellants further submit that the combination of the cited references does not teach or suggest to “prevent forwarding of the digital communication to an unintended recipient” as recited in claim 1 for the reasons set forth above in response to the obviousness rejection of claim 1 over the combination of Turnbull patent and the Liu patent. Appellants respectfully note that the Dickinson publication also does not teach or suggest to “prevent forwarding of the digital

communication to an unintended recipient” as recited in claim 1 and therefore cannot cure the deficiency of the Turnbull patent and the Liu patent.

For the foregoing reasons, Appellants submit that the *prima facie* case of obviousness has not been established and that the combination of the cited references does not render claim 1 obvious.

Claims 3-9, 13-16 and 73 depend from claim 1 and therefore are not rendered obvious by the combination of the cited references by virtue of their dependency from claim 1. *See, e.g., In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988) (“Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious. *Hartness Int’l, Inc. v. Simplimatic Eng’g Co.*, 819 F.2d 1100, 1108, 2 U.S.P.Q.2d 1826, 1831 (Fed. Cir.1987); *In re Abele*, 684 F.2d 902, 910, 214 U.S.P.Q. 682, 689 (CCPA 1982); *see also In re Sernaker*, 702 F.2d 989, 991, 217 U.S.P.Q. 1, 3 (Fed. Cir.1983)”).

Reversal of the rejection of claims 3-9, 13-16 and 73 is respectfully requested.

## 2. Claims 10 and 11: Argued Separately

Claim 10 recites that the communication system of claim 1 “further comprising a confidentiality notice that is displayed to a user and acknowledged by the user before displaying the privileged communication.”

Appellants respectfully submit that the combination of the cited references does not teach or suggest displaying a confidentiality notice “to a user and acknowledged by the user before displaying the privileged communication” as recited in claim 10. The Examiner contended that “Dickinson discloses a confidentiality notice that is displayed to a user and acknowledged by the user before displaying the privileged communication” in paragraph [0039] (i.e., notification actions). *See Office Action*, page 14. Appellants respectfully note that paragraph [0039] of the Dickinson publication states in part that “[n]otification actions 616 cause the sending of one or more e-mail notifications when a given policy is triggered.” *See, the Dickinson publication*, paragraph [0039]. There is nothing in the Dickinson publication that suggests that the sent

notifications may include “a confidentiality notice” as recited in claim 10, or that the sent notifications are “acknowledged by the user” before the privileged communication is displayed as recited in claim 10. In fact, the Dickinson publication states that “[a]dvantageously, embodiments employing the principles of the ... invention [described] therein operate **transparently** to individual users ....” *See Dickinson publication*, paragraph [0009] (emphasis added).

Accordingly, Appellants respectfully submit that the combination of the cited references does not teach or suggest displaying a confidentiality notice “to a user and acknowledged by the user before displaying the privileged communication” as recited in claim 10.

With further regard to claim 11, Appellants submit that the combination of the cited references does not teach or suggest a system “wherein the user acknowledges the confidentiality notice by clicking on a GUI button” as recited in claim 11.

Furthermore, Appellants respectfully note that “[t]he Federal Circuit has stated that ‘rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.’” *See MPEP*, section 2142 (citations omitted).

The only support offered by the Examiner for the rejection of claim 11 is a mere conclusory statement that “it was commonly known to those of ordinary skill in the art and would have been obvious at the time of invention was made to a person having ordinary skill in the art to include clicking on a GUI button for the motivational purpose acknowledging a pop-up window.” *Office Action*, page 15. Appellants respectfully submit that this conclusory statement is insufficient to establish a *prima facie* case of obviousness. *See MPEP*, section 2142 (citations omitted).

Reversal of the rejection of claims 10 and 11 for these additional reasons is respectfully requested.

### 3. Claims 19-21: Argued Separately

Claims 19-21 depend from claim 18. Claim 18 was discussed above.

Appellants respectfully submit that the combination of the cited references does not teach or suggest to attach “an executable module to a digital communication when the digital communication is created” as recited in claim 18 for the reasons set forth above in response to the obviousness rejection over the combination of the Turnbull patent and the Liu patent. The Examiner contended that “Dickinson discloses ... attaching the executable module to particular communications according to predetermined selection criteria (see paragraphs [0022-0031]).” *Office Action*, page 14. Appellants respectfully note that paragraphs [0022] to [0031] of the Dickinson publication purportedly describe “the manner in which **messages received by** the SMTP relay module 202 from internal site 210 and external site 212 are processed by policy engine 214.” *The Dickinson patent*, paragraph [0022] (emphasis added). Appellants therefore submit that the disclosure in these passages cannot read on attaching an executable module to a digital communication “when the digital communication is created” as recited in claim 18, as paragraphs [0022] to [0031] of the Dickinson publication are purportedly directed to the actions which occur after the digital communication is created.

Appellants further submit that the combination of the cited references does not teach or suggest to “prevent forwarding of the digital communication to an unintended recipient” as recited in claim 18, for the reasons set forth above in response to the obviousness rejection of claim 18.

Therefore, Appellants respectfully submit that the *prima facie* case of obviousness has not been established and that the combination of the cited references does not render claim 18 obvious.

Claims 19-21 are not rendered obvious by the combination of the cited references by virtue of their dependency from claim 18.

Reversal of the rejection of claims 19-21 is respectfully requested.



#### 4. Claims 22, 24 and 27: Argued Separately

Claim 22 recites “[t]he communication system of claim 18 further comprising a confidentiality notice that is displayed to a user and acknowledged by the user before displaying the privileged communication.”

Appellants respectfully submit that the combination of the cited references does not teach or suggest displaying a confidentiality notice “to a user and acknowledged by the user before displaying the privileged communication” as recited in claim 22. The Examiner contended that “Dickinson discloses a confidentiality notice that is displayed to a user and acknowledged by the user before displaying the privileged communication” in paragraph [0039] (i.e., notification actions). *See Office Action*, page 14. As submitted above with regard to the rejection of claim 10, there is nothing in the Dickinson publication that suggests that the sent notifications may include “a confidentiality notice” as recited in claim 22, or that the sent notifications are “acknowledged by the user” before the privileged communication is displayed as recited in claim 22. In fact, the Dickinson patent states that “[a]dvantageously, embodiments employing the principles of the ... invention [described] therein operate **transparently** to individual users ....” *See Dickinson patent*, paragraph [0009] (emphasis added).

Accordingly, Appellants respectfully submit that the combination of the cited references does not teach or suggest displaying a confidentiality notice “to a user and acknowledged by the user before displaying the privileged communication” as recited in claim 22, and that claim 22 is not rendered obvious by the combination of the cited references.

Claims 24 and 27 depend from claim 22 and therefore are not rendered obvious by virtue of their dependency from claim 22.

Reversal of the rejection to claims 22-27 on this additional ground is respectfully requested.

5. Claims 41-43 and 45-48: Argued Separately

Independent claim 41 recites:

A method for creating an attorney-client privileged electronic communication comprising the steps of:

- creating an electronic communication;
- marking the electronic communication privileged with a privileged attribute which is selected by the creator of the electronic communication before the electronic communication is sent,
- storing the electronic communication in a segregated location for privileged electronic communications on a data storage device;
- configuring access rights to the electronic communication and associating a privileged distribution list with the digital communication; and
- enforcing said access rights by managing access to the electronic communication and controlling the manipulation of its contents based upon the privileged distribution list;

wherein the access rights include:

- forwarding of the communication;
- replying; and
- replying with copies to pre-selected recipients.

Appellants respectfully submit that the combination of the cited references does not teach or suggest “marking the electronic communication privileged with a privileged attribute which is selected by the creator of the electronic communication before the electronic communication is sent” as recited in claim 41. The Examiner contended that this feature is disclosed in abstract and column 4, lines 7-30, of the Turnbull patent. *Office Action*, page 7. However, Appellants respectfully note that there is no disclosure of any digital communications (i.e., emails) in the portions of the Turnbull patent relied upon by the Examiner in support of his contention. Accordingly, these portions cannot teach or suggest classifying the digital communication as privileged or confidential (i.e., “attach a privileged attribute” to a digital communication) as recited in claim 41. Moreover, there is no mention of “the creator of digital communication” in this portion of the Turnbull patent. Accordingly, this portion cannot teach or suggest a privileged attribute “selected by the creator of the digital communication before the digital communication is sent” as recited in claim 41.

Appellants further submit that the combination of the cited references does not teach or suggest “storing the electronic communication in a segregated location for privileged electronic communications on a data storage device” as recited in claim 41. The Examiner contended that the Liu patent describes this feature in column 21, lines 6-20. As stated above in response to the obviousness rejection of claim 1 over the combination of the Turnbull patent and the Liu patent, the portion of the Liu patent relied upon by the Examiner does not disclose storing a privileged digital communication (i.e., an email) in a segregated location on a data storage device as recited in claim 41, as there is no mention of any digital communications (i.e., emails) in the portion of the Liu patent relied upon by the Examiner. Appellants respectfully reiterate that “a private key” is different from “a privileged digital communication” (i.e., an email) for the reasons set forth above with regard to the obviousness rejection of claim 1.

Accordingly, Appellants submit that the disclosure relied upon by the Examiner does not read on storing a privileged digital communication in a segregated location on a data storage device as recited in claim 41, and that the rejection is deficient as the combination of the cited references does not teach or suggest each and every element of claim 41.

Therefore, Appellants submit that claim 41 is not rendered obvious by the combination of the cited references.

Claims 42-43 and 45-48 depend from claim 41 and therefore are not rendered obvious by the combination of the cited references by virtue of their dependency from claim 41.

Reversal of the rejection of claims 41-43 and 45-48 is respectfully requested.

#### 6. Claim 44: Argued Separately

Claim 44 recites:

The method of claim 41 further comprising: displaying a confidentiality notice to a user; and, requiring acknowledgment by the user of the confidentiality notice before displaying the privileged communication.

Appellants respectfully submit that the combination of the cited references does not teach or suggest the steps of “displaying a confidentiality notice to a user” and “requiring acknowledgment by the user of the confidentiality notice before displaying the privileged communication” as recited in claim 44. In fact, the Dickinson publication states that “[a]dvantageously, embodiments employing the principles of the ... invention [described] therein operate **transparently** to individual users ....” See *Dickinson publication*, paragraph [0009] (emphasis added).

Accordingly, Appellants respectfully submit that claim 44 is not rendered obvious by the combination of the cited references.

Reversal of the rejection of claim 44 is therefore respectfully requested.

7. Claims 50-52 and 54: Argued Separately

Claims 50-52 and 54 depend from claim 49. Claim 49 was discussed above.

Appellants respectfully submit that the combination of the cited references does not teach or suggest “creating an executable module” as recited in claim 49,” for the reasons set forth above with regard to the obviousness rejection of claim 49 over the combination of the Turnbull patent and the Liu patent. Appellants respectfully note that the Dickinson publication also does not teach or suggest “creating an executable module” as recited in claim 49, as it does not mention or describe such a module. Accordingly, the Dickinson publication cannot cure the deficiency of the Turnbull patent and the Liu patent.

Appellants further submit that the combination of the cited references does not teach or suggest “attaching the executable module to the communication ... before the digital communication is sent” as recited in claim 49, for the reasons set forth above with regard to the obviousness rejection of claim 49 over the combination of the Turnbull patent and the Liu patent. As stated above, Dickinson publication is purportedly directed to an e-mail firewall and therefore describes actions which occur after the digital communication is sent. Accordingly, the Dickinson publication does not teach or suggest “attaching the executable module to the

communication ... before the digital communication is sent” as recited in claim 49, and therefore does not cure the deficiency of the Turnbull patent and the Liu patent.

Accordingly, Appellants respectfully submit that claim 49 is not rendered obvious by the combination of the cited references.

Claims 50-52 and 54 depend from claim 49 and therefore are not rendered obvious by the combination of the cited references by virtue of their dependency from claim 49.

Reversal of the rejection of claims 50-52 and 54 is respectfully requested.

#### 8. Claim 55: Argued Separately

Claims 55 recites the steps of “displaying a confidentiality notice to a user and requiring that the confidentiality notice be acknowledged by the user before the privileged communication is displayed.”

Appellants respectfully submit that the combination of the cited references does not teach or suggest the steps of “displaying a confidentiality notice to a user” and “requiring acknowledgment by the user of the confidentiality notice before displaying the privileged communication” as recited in claim 55. In fact, the Dickinson publication states that “[a]dvantageously, embodiments employing the principles of the ... invention [described] therein operate **transparently** to individual users ....” See Dickinson patent, paragraph [0009] (emphasis added).

Accordingly, Appellants respectfully submit that claim 55 is not rendered obvious by the combination of the cited references for this additional reason.

Reversal of the rejection of claim 55 is respectfully requested.


For the foregoing reasons reversal of the obviousness rejection of claims 3-11, 13-16, 19-22, 24, 27, 41-48, 50-52, 54-55, and 73 is respectfully requested.

CONCLUSION

It is respectfully submitted that the application is in condition for allowance. Favorable consideration of this Appeal Brief is respectfully requested.

Respectfully submitted,

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**APPENDIX A:**

**PENDING CLAIMS 1-27, 41-59 AND 71-73 OF  
U.S. APPLICATION SERIAL NO. 09/825,431**

Claim 1 (previously presented): A digital communication system to denote confidentiality of a digital communication comprising:

a first memory containing a program executable by a processor to:

attach a privileged attribute to a digital communication, the privileged attribute selected by the creator of the digital communication before the digital communication is sent; and

create a privileged distribution list of at least one intended recipient and associate the privileged distribution list with the digital communication when the digital communication is created; and

a second memory containing a program executable by a processor to:

restrict access to the privileged digital communication to the at least one intended recipient according to the privileged distribution list;

restrict routing of the privileged digital communication to the intended recipients and prevent forwarding of the digital communication to an unintended recipient; and

store the privileged digital communication in a segregated location for privileged digital communications on a data storage device,

wherein the intended recipients are selected by the creator of the digital communication before the digital communication is sent.

Claim 2 (original): The communication system of claim 1, wherein the at least one intended recipient is a plurality of intended recipients.

Claim 3 (previously presented): The communication system of claim 1 further comprising:

a mail server; and,

a segregated server housing the segregated location for privileged digital communications;

wherein the program is further executable to send a copy of the communication to the segregated server.

Claim 4 (original): The communication system of claim 3, wherein the copy is sent as a blind carbon copy.

Claim 5 (previously presented): The communication system of claim 1 wherein the segregated location for privileged digital communications is divided by a common characteristic of the digital communication, the common characteristic including:

- a sender of the digital communication;
- a recipient of the digital communication; and,
- a department of a corporation using the system.

Claim 6 (previously presented): The communication system of claim 1 wherein the program is further executable to configure access rights to the digital communication and to enforce said access rights by managing access to the digital communication and controlling the manipulation of its contents.

Claim 7 (original): The communication system of claim 6 wherein the access rights include:

- forwarding of the communication;
- replying; and
- replying with copies to pre-selected recipients.

Claim 8 (original): The communication system of claim 6 wherein the communication includes an address portion and a content portion, and wherein the access rights further include:

- allowing copying of the contents of the communication; and
- allowing cutting the contents of the communication out of the communication and pasting the cut out contents into another location.

Claim 9 (original): The communication system of claim 1 wherein the program is configured to



execute automatically and attach the privileged attribute to particular communications according to predetermined selection criteria.

Claim 10 (original): The communication system of claim 1 further comprising a confidentiality notice that is displayed to a user and acknowledged by the user before displaying the privileged communication.

Claim 11 (original): The communication system of claim 10 wherein the user acknowledges the confidentiality notice by clicking on a GUI button.

Claim 12 (original): The communication system of claim 1 wherein the privileged digital communication is encrypted.

Claim 13 (original): The communication system of claim 1 wherein the program further comprises a server object and a client object.

Claim 14 (original) The communication system of claim 13 wherein the client object is configured to attach the privileged attribute, create the privileged distribution list and send the privileged communication to the server object.

Claim 15 (original): The communication system of claim 13 wherein the server object restricts access and routing of the digital communication and stores the communication in the segregated location.

Claim 16 (original): The communication system of claim 13 wherein the client object is a plug-in to a pre-existing communication system.

Claim 17 (original): The communication system of claim 1 further comprising a second segregated location residing on a client device.

Claim 18 (previously presented): A digital communication system for denoting confidentiality of a digital communication comprising:

- a processor; and
- a memory containing a program executable by the processor to attach an executable module to a digital communication when the digital communication is created, the executable module constructed and arranged to:
  - create a privileged distribution list of intended recipients of the digital communication to which it is attached when the digital communication is created;
  - restrict access to the digital communication to which it is attached to the intended recipients; and
  - restrict routing of the digital communication to which it is attached to the intended recipients and prevent forwarding of the digital communication to an unintended recipient, wherein the intended recipients are selected by the creator of the digital communication before the digital communication is sent.

Claim 19 (original): The communication system of claim 18 wherein the program is further executable to configure access rights to the digital communication and to enforce said access rights by managing access to the digital communication and controlling the manipulation of its contents, wherein the access rights include:

- allowing forwarding of the communication;
- allowing replying; and
- allowing replying with carbon copies to pre-selected recipients.

Claim 20 (original): The communication system of claim 18 wherein the communication includes an address portion and a content portion, and wherein the access rights further include:

- allowing copying of the contents of the communication;
- allowing cutting the contents of the communication out of the communication and
- pasting the cut out contents into another location;

Claim 21 (original): The communication system of claim 18 wherein the program is configured

to execute automatically and attach the executable module to particular communications according to predetermined selection criteria.

Claim 22 (original): The communication system of claim 18 further comprising a confidentiality notice that is displayed to a user and acknowledged by the user before displaying the privileged communication.

Claim 23 (original): The communication system of claim 18 wherein the privileged digital communication is encrypted.

Claim 24 (original): The communication system of claim 18, wherein the program further comprises a server object and a client object.

Claim 25 (original): The communication system of claim 23 wherein the client object is configured to attach the executable module, and send the privileged communication to the server object.

Claim 26 (original): The communication system of claim 23 wherein the server object restricts access and routing of the digital communication and stores the communication in a segregated location.

Claim 27 (original): The communication system of claim 23 wherein the client object is a plug-in to a pre-existing communication system.

Claims 28-40 (canceled)

Claim 41 (previously presented): A method for creating an attorney-client privileged electronic communication comprising the steps of:

- creating an electronic communication;
- marking the electronic communication privileged with a privileged attribute which is

selected by the creator of the electronic communication before the electronic communication is sent,

storing the electronic communication in a segregated location for privileged electronic communications on a data storage device;

configuring access rights to the electronic communication and associating a privileged distribution list with the digital communication; and

enforcing said access rights by managing access to the electronic communication and controlling the manipulation of its contents based upon the privileged distribution list;

wherein the access rights include:

forwarding of the communication;

replying; and

replying with copies to pre-selected recipients.

Claim 42 (original): The method of claim 41 wherein the communication includes an address portion and a content portion, and wherein the access rights include:

copying of the contents of the communication;

cutting the contents of the communication out of the communication and

pasting the cut out contents into another location.

Claim 43 (original): The method of claim 41 further comprising automatically attaching the privileged attribute to particular communications according to pre-determined selection criteria.

Claim 44 (original): The method of claim 41 further comprising:

displaying a confidentiality notice to a user; and,

requiring acknowledgment by the user of the confidentiality notice before displaying the privileged communication.

Claim 45 (original): The method of claim 41 further comprising applying an encryption technique to the digital communication.

Claim 46 (original): The method of claim 41 further comprising the steps of:

- creating a blind carbon copy of the digital communication;
- sending the blind carbon copy to a segregated server wherein the segregated location resides on the segregated server.

Claim 47 (original): The method of claim 41 further comprising dividing the segregated location by a common characteristic of the digital communication, the common characteristic including one or more of:

- a sender of the digital communication;
- a recipient of the digital communication; and
- a department of a corporation.

Claim 48 (previously presented): The method of claim 41 further comprising the steps of:

- creating a second segregated location on a client device;
- storing a copy of the digital communication on the second segregated location for privileged digital communications.

Claim 49 (previously presented): A method for creating a digital communication protected by privilege comprising the steps of:

- creating an executable module constructed and arranged to instruct a computer, according to a privileged distribution list associated with the digital communication when the digital communication was created, to restrict access to the communication to which the executable module is attached in order to maintain the application of the privilege;
- attaching the executable module to the communication, whereby the executable module instructs the computer to restrict access to the communication to recipients selected by the creator of the digital communication before the digital communication is sent.

Claim 50 (original): The method of claim 49 further comprising:

- configuring access rights to the digital communication;
- enforcing said access rights by managing access to the digital communication and

controlling the manipulation of its contents.

Claim 51 (original): The method of claim 49 wherein the access rights include:

- forwarding the communication;
- replying; and
- replying with carbon copies to pre-selected recipients.

Claim 52 (original): The method of claim 49 wherein the communication includes an address portion and a content portion, and wherein the access rights include:

- copying of the contents of the communication;
- cutting the contents of the communication out of the communication and pasting the cut out contents into another location.

Claim 53 (previously presented): The method of claim 49 further comprising creating a privilege profile, the profile containing the privileged distribution list and the access rights.

Claim 54 (original): The method of claim 49 wherein the program is configured to execute automatically and attach the executable module to particular communications according to predetermined selection criteria.

Claim 55 (previously presented): The method of claim 49 further comprising displaying a confidentiality notice to a user and requiring that the confidentiality notice be acknowledged by the user before the privileged communication is displayed.

Claim 56 (original): The method of claim 49 further comprising applying an encryption technique to the digital communication.

Claim 57 (previously presented): A method for creating a privileged digital document, comprising the steps of:

- creating an executable module which instructs a computer to maintain confidentiality in

communication of the privileged digital document to which the executable module is attached by restricting access to the digital document and managing manipulation of its contents, according to a privileged distribution list created and associated with the digital document;

attaching the executable module to the privileged digital document, whereby the executable module instructs the computer to restrict access to the privileged digital document to recipients selected by the creator of the privileged digital document before the privileged digital document is sent.

Claim 58 (original): The method according to claim 57, further comprising the step of executing the executable module when the document is opened.

Claim 59 (original): The method of claim 57, wherein the document is an encrypted document, and wherein the executable module is configured to instruct the computer to decrypt the document if a predetermined condition is met.

Claims 60-70 (canceled)

Claim 71 (previously presented): A digital communication system to comprising:

a first memory containing a program executable by a processor to:

attach a privileged attribute to a digital communication, the privileged attribute selected by the creator of the digital communication before the digital communication is sent;

a second memory containing a program executable by a processor to:

restrict access to the privileged digital communication to an intended recipient and pre-registered designees of attorney recipients in accordance with the privileged attribute; and

store the privileged digital communication in a segregated location for privileged digital communications on a data storage device.

Claim 72 (previously presented): A digital communication system comprising:

a processor; and  
a memory containing a program executable by the processor to attach an executable module to a digital communication when the digital communication is created, the executable module constructed and arranged to:

restrict access to the digital communication to which it is attached to an intended recipient and pre-registered designees of attorney recipients selected by the creator of the digital communication before the digital communication is sent;

restrict routing of the digital communication to which it is attached to the intended recipient and pre-registered designees of attorney recipients.

Claim 73 (previously presented): The digital communication system of claim 1, wherein the privileged distribution list is created from the at least one intended recipient e-mail address in a "To" text box of the digital communication.



## **APPENDIX B**

### Evidence Appendix under 37 C.F.R. §41.37 (c) (ix):

No evidence pursuant to 37 C.F.R. §§1.130, 1.131 or 1.132 and relied upon in the appeal has been submitted by appellants or entered by the examiner.

## **APPENDIX C**

### Related proceedings appendix under 37 C.F.R. §41.37 (c) (x):

As stated in “2. RELATED APPEALS AND INTERFERENCES” of this appeal brief, appellants, their legal representatives, and assignee are not aware of any appeal or interference that directly affects, will be directly affected by, or will have a bearing on the Board’s decision in this appeal.